

REMARKS/ARGUMENTS

In the August 27, 2009 Office Action, the Examiner rejected claims 1-11 pending in the application. This response amends claims 1, 2, and 3 for further consideration. After entry of the foregoing amendments, claims 1-11 (1 independent claim; 11 total claims) remain pending in the application. Reconsideration is respectfully requested.

The Examiner first rejected claim 3 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response to the Examiner's rejection, Applicant has amended claim 3 to more particularly define the subject matter of Applicant's claim 3.

Claims 1-2 and 4-11 stand rejected under 35 U.S.C. §102(e) as being anticipated by Arnold, Jr. et al., U.S. Patent Publication No. 2003/0129089 A1 (hereafter "Arnold"). In particular, the Examiner states that Arnold teaches an apparatus for transferring pipette tips comprising: 1) a transfer plate 36 having a plurality of plug members 38 for engaging pipette tips 11 wherein the plurality of plug members are part of the transfer plate, and 2) a frame assembled and interlocked with the transfer plate, the frame having openings 22 contained therein for inserting the plug members therethrough and a plurality of protuberances 23 smaller than the plug members and extending into the openings wherein the protuberances are part of the frame 20. In addition, the Examiner states that with respect to claim 2, the plug members 38 are arranged in parallel lines separated by elongated slots created by the shoulders 42 (see Fig. 6). Further, with respect to claim 4, the Examiner contends that Arnold teaches all of the components including the transfer plate and frame being made of plastic. The Examiner further states that it is the inherent nature of plastic to be "moldable" given the necessary pressure and/or temperature.

With respect to claim 5, the Examiner contends that the plug members 38 are hollow. In addition, with respect to claim 6, the Examiner states that claim 6 functionally describes the operation of the apparatus. The Examiner also states that a recitation with respect to manner in which a claimed apparatus is intended to be operated fails to differentiate the claimed apparatus from prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. The Examiner then states that the retained and released positions are not structurally

defined in the claims but that, nevertheless, Arnold does teach vertically sliding the transfer plate 36 (e.g., down) relative to the frame 20. The Examiner also states that the transfer plate 36 can be slid downward to a retained position and a release position when the plugs 38 have pipette tips 11 positioned thereon.

With respect to claim 7, the Examiner states that the protuberances 23 contact the pipette tips 11 positioned over the plug members 38 on transfer plate 36 when the apparatus is in the retained position as shown in Fig. 6. Further, with respect to claim 8, the Examiner contends that the protuberances 23 are located between the shoulders 41 of plug members 38 when the apparatus is in a release position (see Fig. 8). Further, with respect to claim 9, the Examiner states that the transfer plate 36 further comprises at least one “tab member” for sliding the frame relative to the transfer plate. In particular, the Examiner states that the flat body 37 of the transfer plate 36 in Arnold reads on the “tab member” since it projects horizontally from the plug members so that the user may use the overhang to grip and slide the transfer plate 36 relative to the frame 20. With regard to claim 10, the Examiner states that the transfer plate 36 and the frame 20 are generally rectangular in shape. Finally, with regard to claim 11, the Examiner contends that the transfer plate 36 and the frame 20 are removable from one another. Applicant respectfully traverses this rejection.

Applicant’s currently amended independent claim 1 (and as a result dependent claims 2 and 4-11) require a frame having horizontal elongated slots contained therein, coplanar horizontal elongated rails separating the horizontal elongated slots, and a plurality of protuberances extending from the coplanar horizontal elongated rails into the horizontal elongated slots wherein the protuberances are part of the frame. Arnold fails to disclose a plate (whether it is the push plate in Arnold or the transfer plate in Arnold) which includes horizontal elongated slots contained therein, coplanar horizontal elongated rails separating the horizontal elongated slots, and a plurality of protuberances which extend from the coplanar horizontal elongated rails into the horizontal elongated slots. Accordingly, in that Arnold fails to disclose each and every element of Applicant’s claims, Arnold cannot anticipate Applicant’s claims.

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Arnold. In particular, the Examiner states that while Arnold does show circular openings 22 in the frame 20

that are separated by elongated rails 27, Arnold is silent to the shape of the openings being horizontal elongated slots. However, the Examiner then contends that it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to construct the openings in the frame as horizontal elongated slots since the skilled artisan would be able to determine the optimum shape for holding the pipette tips securely in the frame yet large enough that the tips don't become difficult to remove from the frame. In addition, the Examiner contends that it has been held that changes in shape are a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed element was significant. Applicant respectfully traverses this rejection.

As previously stated above, Applicant's currently amended claim 3 requires a frame having horizontal elongated slots, coplanar horizontal elongated rails separating the horizontal elongated slots, and a plurality of protuberances extending from the coplanar horizontal elongated rails into the horizontal elongated slots. Although the Examiner contends that Arnold teaches circular openings 22 in the frame 20 that are separated by elongated rails 27, Arnold fails to disclose horizontal elongated slots and coplanar horizontal elongated rails that separate the horizontal elongated slots with protuberances extending from the coplanar horizontal elongated rails into the horizontal elongated slots. Arnold fails to specifically disclose Applicant's claim element of coplanar horizontal elongated rails which separate the horizontal elongated slots which comprise part of the frame of the apparatus. Accordingly, in that Arnold fails to disclose this element, and further in that this element would not be obvious to one of ordinary skill in the art to provide given the teachings of Arnold, Applicant's claimed invention cannot be obvious given the Arnold reference.

In view of the foregoing, Applicant respectfully submits that all of the pending claims fully comply with 35 U.S.C. §112 and are allowable over the prior art of record. Reconsideration of the application and allowance of all pending claims is earnestly solicited. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to telephone the undersigned at the Examiner's convenience. Applicants authorize and respectfully

request that any fees due be charged to Deposit Account No. 19-2814. **This statement does NOT authorize charge of the issue fee.**

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Respectfully submitted,

By



Laura J. Zeman
Reg. No. 36,078

SNELL & WILMER L.L.P.

One Arizona Center

400 East Van Buren

Phoenix, Arizona 85004-2202

Telephone: (602) 382-6377

Facsimile: (602) 382-6070